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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,568	07/11/2003	Frank Robert Nemirofsky	6555/53772	3762

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EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/618,568

Applicant(s)

NEMIROFSKY ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/13/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to the paper(s) filed 12/13/06.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 sets forth a system having an interface server which interacts with a remote device. However, the claim appears to attempt to further limit the server's capability for receiving a code by stating how the code was previously delivered to the customer and how the code was previously captured by the customer's device. Applicant's amendment appears to represent past-tense method steps rather than capabilities of the server, confusing the claim scope. The structure representative of this interface server cannot be further defined by implying how a user received the code previously. In fact, looking to claim 8 which defines the server as DTMF, it is clear that the server indeed can have no qualities whatsoever regarding the delivery/capturing steps regarding the original message code. It is unclear what structure is responsible for these alluded-to features.

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- Claims 16 and 19 are rejected for the same reasons as claim 1 above. It is unclear what structure of applicant's server system is responsible for either the step of or the capability for capturing, processing the image and resolving the code.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-8, 13, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aggarwal et al (US7013286) in view of Naftzger (US5717866).**

As best understood regarding claims 1, 4-7, Aggarwal et al teaches a system where a user may access the world wide web using a device such as a phone [9:30-32] and after completing prerequisites or user actions [9:41-43, 11:59-61, 12:25-28] the user can receive a product coupon downloaded to their coupon wallet/phone [9:36-48, 12-19]. The coupons provided by Aggarwal et al are targeted and personalized for users [7:29-31, 41-46, 53-56, 9:63-65] and are thusly taken to provide a teaching for a user account database, user identification and a targeted user characteristic. Aggarwal et al states that the system can be used to offer different promotional schemes for different products [6:1]. Aggarwal et al does not however require the user to enter a publicized promotional code. Naftzger however teaches the concepts of including

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codes in various product advertising (newspaper, radio, TV) and requiring a consumer to electronically enter the code in order to receive a discount for the advertised product. In this manner, differently coded advertising sources advertising the same product can reveal the relative successes of each advertising source [15:32-62]. It would have been obvious to one of ordinary skill at the time of the invention to have provided coded advertising for the products available for discounting on the system of Naftzger in order to encourage web visitors to identify published codes so that the promoted products in the system of Aggarwal et al can be analyzed in terms of various advertising effectiveness. Applicant's language attempting to define steps related to code delivery and capture by the user's device are not taken to limit the interface server apparatus in any way and at best are not taken to provide positive limitations regarding the server. The server proposed by the prior art combination does not fail to address any positive server limitation in the claims. Nonetheless, Aggarwal et al teaches that the customer could respond to a banner ad (i.e. an image downloaded/captured/presented on a display device) in order to request the coupon [col 8 lines 12-16]. It would have been obvious to one of ordinary skill at the time of the invention to have provided Naftzger's codes with the banner ad campaigns of Aggarwal et al in order to track the efficiency of the banner ad.

Regarding claims 2-3, the electronic coupons of Aggarwal et al are taken to provide "promotional messages."

Regarding claims 8, Official Notice is taken that DTMF input systems are notoriously well known for entering numeric data on telephones. It would have been

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obvious to one of ordinary skill at the time of the invention to have provided such a known signaling protocol with the interactive phone users of Aggarwal et al in order to input the necessary codes as taught by Naftzger.

Regarding claims 13, 14, Aggarwal et al teaches that the coupons can be targeted according to various rules including being targeted to a user's city [7:53-54].

3. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aggarwal et al (US7013286) in view of Naftzger (US5717866) and Jun et al (KR2001/097065). Regarding claims 9-12, Jun et al teaches the concepts of an interactive cell phone user receiving electronic coupons via the known SMS messaging protocol. It would have been obvious to one of ordinary skill at the time of the invention for the user to have sent the appropriate codes to the system using any well known protocol including SMS and for the coupons to be delivered using SMS. Further, Aggarwal et al teaches that the coupons can include various multimedia formats [8:4-6] and because MMS is a known multimedia extension to SMS messaging, it would have been obvious to one of ordinary skill at the time of the invention to have delivered Aggarwal et al's multimedia coupon formats in such an MMS format.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aggarwal et al (US7013286) in view of Naftzger (US5717866) and Kepecs (US6330543). Aggarwal et al teaches that the phone user is identified using a variety of methods and in fact states that any form of identification may be used. Kepecs also

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teaches an interactive phone user accessing a centralized electronic coupon system. Kepecs teaches that a user's unique ID may be bound to his own calling number. It would have been obvious to one of ordinary skill at the time of the invention to have used such a callerID approach in order to identify the user accounts in the user database of Aggarwal et al.

5. **Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aggarwal et al in view of Naftzger as above and further in view of Greenberg et al (WO 00/39657).** Greenberg et al teaches a cell phone that stores electronic coupons and further displays a barcode image of the coupon which can be scanned at a retailer upon redemption [fig 3D – element 76, page 16:11-14]. It would have been obvious to one of ordinary skill at the time of the invention to have enabled the display of coupon barcode images on the phone of Aggarwal et al for automating the redemption of the coupons.

6. **Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aggarwal et al (US7013286) in view of Naftzger (US5717866), Greenberg et al and Jun et al (KR2001/097065).** Jun et al teaches the concepts of an interactive cell phone user receiving electronic coupons via the known SMS messaging protocol. It would have been obvious to one of ordinary skill at the time of the invention for the user to have sent the appropriate codes to the system using any well known protocol including SMS and for the coupons to be delivered using SMS. Further, Aggarwal et al

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teaches that the coupons can include various multimedia formats [8:4-6] and because MMS is a known multimedia extension to SMS messaging, it would have been obvious to one of ordinary skill at the time of the invention to have delivered Aggarwal et al's multimedia coupon formats in such an MMS format.

Response to Arguments

Applicant argues that the art fails to provide the features of the newly amended claims. However, applicant has not clearly and positively provided limitations in the claims which further define the structural (capabilities) of the server system. As such, the server features of the applied art still read on the claims. Further, as stated above, both presenting a coded ad on a TV display and/or a coded banner ad accessed via the user device provide displayed and captured images which are used as a basis for reporting a code to the interface server.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc